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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/887,680	07/03/1997	MICHAEL POWELL	82225.P0189R	1324

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025

EXAMINER

ENG, DAVID Y

ART UNIT PAPER NUMBER

2155

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

08/887,680

Applicant(s)

POWELL ET AL.

Examin r

DAVID Y. ENG

Art Unit

2155

-- Th MAILING DATE of this communication appears on the cov r sh et with the correspond nc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-32 is/are allowed.
- 6) ☒ Claim(s) 33-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

This is in response to the remand of the application to the Examiner for a determination of whether the rejection under 35 U.S.C. § 251 remains appropriate in view of Ex parte Eggert.

The rejection of claims 33-38 under 35 U.S.C. § 251 is hereby withdrawn in view of Ex parte Eggert. In Eggert, reference is made to two concentric circles shown in Drawing 1. The outer circle represents the scope of rejected claim (broad, claim 55 of patent application 08/321,459) and the inner circle represents the scope of amended issued claim (narrow, claim 73 of patent application 08/321,459 and renumbered as claim 1 in USP 5,430,864). The shaded area between the two concentric circles represents subject matter which is narrower than the scope of the rejected claim 55 but broader than the scope of the issued claim 1. The surrendered subject matter is the outer circle of Drawing 1 because it is the subject matter Appellants conceded was unpatentable. The two circles are used as scope reference for the reissue claims. If the alleged error is the patentee claiming less than he had a right to claim in the patent, there is no recapture if the circle representing the scope of reissue claims falls in the shaded concentric area and recapture is in effect if the circle representing the scope of reissue claims falls outside the outer circle.

In amendment G of the patent application file (08/321,459) submitted on October 11 1994, Appellants cancelled all previous claims 55-72 in favor of the newly added claims 73-88 (renumbered as claims 1-16 in reissue patent USP 5,430,864). The scope of claim 55 which constitutes surrendered subject matter is represented by the outer circle and the scope of claim 73 is represented by the inner circle. We need to

determine whether the scope of reissue claim 33 falls outside the outer circle (recapture in effect) or inside the outer circle (no recapture).

When comparing reissue claim 33 to cancelled claim 53, two aspects of the reissue claim 33 are found different. 1. Reissue claim 33 recites "least significant bit" instead of "an indication bit". Scope of claim 33 is narrower than claim 55 in this aspect. 2. Reissue claim 33 does not recite setting an indication bit corresponding to the procedure in a stack save area (the last paragraph of claim 55) if the indication bit in the stack pointer register indicates second number of bits. Scope of claim 33 is broader than claim 55 in this aspect. Reissue claim 33 therefore falls in the shaded area. According to Ex parte Eggert, no recapture is in effect if reissue claim falls in the shaded area of two concentric circles. The rejection of claims 33-38 under 35 U.S.C. § 251 is therefore withdrawn in view of Ex parte Eggert.

Claims 33-38 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: 1. transferring a least significant portion of a stack pointer value from the stack pointer register to the first stack save area if the least significant bit of the stack pointer register indicates the first word size, and 2. setting a width indication bit in the first stack save area in memory if the least significant bit of the stack pointer register indicates second word size such that the width indication bit in the first save area in memory indicates that the data values for the procedure have the second word size.

The preamble of claim 33 calls for a method for context switching. In context switching, the processor would go back to the original state after serving the interrupt. The original state requires the processor be indicated whether the data values in the internal registers have the first or the second word size. Without the two steps, the processor would not be able to know whether the data values in the internal registers have the first or the second word size. The two steps are essential because without them the processor is inoperative.


If claims are amended, a supplemental declaration for reissue patent application to correct error statement is required.

Claims 1-32 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID Y. ENG whose telephone number is 571-272-3984. The examiner can normally be reached on M-F from 8AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SALEH NAJJAR, can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DAVID Y. ENG
PRIMARY EXAMINER